

### REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendment and the following discussion, is respectfully requested.

Claims 33, 34, 37-57, 60-71, 74-84, 87-96, and 99-119 are pending; Claims 47, 48, 53 and 56 are amended; Claims 54-55; and Claims 1-32, 35-36, 58-59, 72-73, 85-86, and 97-98 were previously canceled. The claims have been amended to address cosmetic matters of form. Thus, no new matter is presented.

This amendment is submitted in accordance with 37 C.F.R. §1.116 which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, or presenting rejected claims in better form for consideration on appeal. It is therefore respectfully requested that the present amendment be entered under 37 C.F.R. §1.116.

In the outstanding Official Action, Claims 33, 34, 38-55, 63, and 109-115 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein (U.S. Pat. No. 5,410,326, hereinafter “Goldstein”) in view of Holman (U.S. Pat. No. 5,287,181, hereinafter “Holman”); Claims 56-57, 60-71, 74-84, 87-96, and 99-108 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Holman, and further in view of Kishtaka (U.S. Pat. No. 6,084,643, hereinafter “Kishtaka”); and Claim 37 was rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Holman, and further in view of Maa (U.S. Pat. No. 5,818,935, hereinafter “Maa”).

With regard to the rejections of Claims 33, 34, and 37-55, this rejection is respectfully traversed.

Amended Claim 33 recites, *inter alia*, a control device comprising:

“... a memory configured to store at least a portion of  
said additional information; and...  
wherein the additional information includes  
advertisement information...”

wherein the advertisement information includes coupon information, and wherein the coupon information is stored in said memory when a user selects the coupon information.”

Amended independent Claims 47-49, 53-56, 70, 83 and 95 recite analogous features. The claim limitations enable a broadcaster to communicate advertisement information, such as a coupon, directly to a user via a remote device, such as a television remote control.<sup>1</sup> Thus, the user is then able to selectively store information in the memory by depressing a key on the remote control device.<sup>2</sup>

Goldstein relates to a programmable remote control device for interacting with a plurality of remotely controlled devices. Goldstein describes a handheld device permitting the automated dialing of a telephone number based on the actuation of a preprogrammed switch of the device.<sup>3</sup> Goldstein's device also includes RAM memory module (90) in a ROM memory module (91). The ROM memory (91) is used to store various operating system components allowing the processor to perform its required functions.<sup>4</sup> The RAM memory (90) is used to store icons representing services, to which the user of the device has subscribed, and further information such as operating system instructions downloaded to the remote control device.<sup>5</sup> Further, Goldstein describes that favorite channel information is stored in RAM 90 based on keypad inputs from the user, however this function does not involve storing information received at the remote control device from an external input.<sup>6</sup>

Holman describes a method for storing coupon information transmitted over a cable television signal to a dedicated device.<sup>7</sup> Specifically, Holman describes that a logo or emblem (40) is viewed on a television screen (38) of a broadcast being viewed by a user.<sup>8</sup> If

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<sup>1</sup> Specification at pages 29-32.

<sup>2</sup> Specification at page 16, lines 10-16.

<sup>3</sup> Goldstein, Abstract.

<sup>4</sup> Goldstein at column 12, lines 34-47.

<sup>5</sup> Id.

<sup>6</sup> Goldstein at column 26, lines 27-39.

<sup>7</sup> Holman at Abstract.

<sup>8</sup> Holman at column 6, lines 5-10.

the viewer is then interested in the product which is the subject of the commercial, the user pushes a "VIEW" button (9) and a message (8) is decoded from the television signal transmission and displayed along the bottom of the television screen (38).<sup>9</sup> Based on the input from the remote control device (43) this extracted information is stored in a dedicated device (i.e., electronic coupon home unit) which is attached to the cable box. The coupons can then be printed from the electronic coupon home unit and redeemed at a store.

The requirements for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the outstanding Office Action fails to make a *prima facie* case of obviousness, because Goldstein and Holman either alone or in combination fail to teach or suggest all the claim limitations and there is no suggestion or motivation to combine the reference teachings.

Goldstein fails to teach or suggest a control device including a memory configured to store at least a portion of received additional information based on a user selection, the additional information including advertisement information, as recited in amended Claim 33. Goldstein includes RAM memory (90) and ROM memory (91). However, these memory devices in Goldstein are used to store various operating system components and icons representing services to which the user devices subscribed. The Official Action has mischaracterized Applicant's previous response by stating:

"as stated in the Applicant's response, the RAM 90 is used to store additional information that is downloaded to the remote control device (see paragraph 2 page 25 of Applicant's response). Thus, since downloaded information can be related to a detected message from the user, such as advertising messages, it is imperative that

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<sup>9</sup> Id.

the RAM 90 of Goldstein is used for storing advertising information.”<sup>10</sup>

Applicants note that the language “additional information” was used in its generic sense in the previous response to refer to the operating system components identified in the corresponding cited portion of Goldstein. This language was not a reference to the Applicants claim terminology, Goldstein fails to teach or disclose that any advertising information received by the receiving device is stored in memory, as recited in amended Claim 33.

Further, as admitted in the Official Action, Goldstein fails to teach coupon information is stored to memory when a user selects the coupon information, and deleting the information stored in the memory. In order to cure the deficiencies of Goldstein the Official Action relies on Holman.

Claim 33 recites a control device including a memory configured to store at least a portion of received additional information based on a user selection, the additional information including advertisement information. In contrast, Holman describes the electronic coupon system home unit, depicted in Figure 2 includes a card writer/reader (45) which is the memory used to store selected advertisement or coupon information. The remote control device (43), however, which is used to select specified selected advertisement information, fails to include a memory for storing such information, as recited in amended Claim 33.

The Official Action states that it would have been obvious to one of ordinary skill in the art to modify Goldstein by adding the teachings of Holman, but provides no motivation or suggestion for combining the reference teachings.

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<sup>10</sup> Official Action at page 2, lines 16-20.

Further, there is no discernible suggestion or motivation to combine the reference teachings as Holman provides a dedicated device for storing coupons. The memory to which selected information is stored in Holman is clearly not located within control device, but instead is located in an external processing device with which the remote control device communicates, as described above. Therefore, modifying Goldstein with the teachings of Holman would make Goldstein's device unfit for its intended purpose because it would result in the addition of another device to which the remote control device to communicate. In other words, Holman teaches away from Goldstein enabling the user to perform a variety of functions by way of a single remote control device. A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, "disclosures in the references that diverge from and teach away from the invention cannot be disregarded", Phillips Petroleum Company v. U.S. Steel Corp., 9 USPQ2d 1461 (Fed. Cir. 1989).

Accordingly, Applicants respectfully request the rejection of Claims 33, 34, 37-55, 63 and 109-115 under 35 U.S.C. § 103(a) be withdrawn. With regard to the rejection of Claims 56-57, 60-71, 74-84, 87-96, and 99-108 under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Holman and in further view of Kishtaka, this rejection is respectfully traversed.

As discussed above, Goldstein neither alone nor in combination with Holman, teaches nor suggests storing additional information provided from a control device at a memory included in a receiving device, as recited in amended Claim 33. Likewise, Kishtaka does not remedy this deficiency, and therefore none of the cited references either alone or in combination, can properly be asserted as disclosing or suggesting Applicants' Claims 56, 57,

60-71, 74-84, 87-96, and 99-108 which include the above-distinguished limitations by virtue of independent recitation or dependency. Therefore, the Official Action fails to provide a *prima facie* case of obviousness with regard to any of these claims.

Similarly, with regard to the rejection of Claim 37 under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Holman and in further view of Maa, that rejection is respectfully traversed.

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The features of Claim 37 were previously addressed with regard to the combination of Goldstein and Holman above. As Maa is not relied upon to provide the features identified as deficient in the combination of Goldstein and Holman, Maa is not substantively addressed herewith, and it is respectfully requested that this rejection be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 33, 34, 37-57, 60-71, 74-84, 87-96, and 99-119 is patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

**Should the above distinctions be found unpersuasive, Applicants respectfully request that the Examiner provide an explanation via Advisory Action pursuant to M.P.E.P. § 714.13 specifically rebutting the points raised herein for purposes of facilitating the appeal process.**

Respectfully submitted,

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OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

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Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Scott A. McKeown  
Registration No. 42,866